UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,674	09/28/2005	Paul Butcher	MARKS9.002APC	7391

20995   7590   07/01/2008
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EXAMINER
NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
2143	

NOTIFICATION DATE	DELIVERY MODE
07/01/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2005*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-15* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11 and 13-15* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *12 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *10052005*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Claims 1-11 and 13-15 are currently presented and have been examined.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 5 October 2005 was
filed before the mailing of an action on the merits. The submission is in compliance with
the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is
being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as
being indefinite for failing to particularly point out and distinctly claim the subject matter
which applicant regards as the invention.

Claims 1-11 and 13-15 recite "said local storage structure" and "said local
storage". There is insufficient antecedent basis in the claim for these limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 7, 10, and 15 are rejected under 35 U.S.C. 101 the claimed invention is
directed to non-statutory subject matter.

Claim 7 recites "wherein the processor implementable instructions are carried by a data carrier".

Signals used as readable media are not statutory subject matter since a signal encoded with functional descriptive material does not fall under any of the four statutory classes. See *In re Nuijten*, 500 F.3d 1346, 1358 (Fed. Cir. 2007).

Claims 10 and 15 recite an email management system and a document management system. Within the specification, it is disclosed that "...the e-mail browser/manager is sometimes called a Mail User Agent (MUA)." It also disclosed that "Related systems, methods and terminals may be used for managing documents stored in folders instead of emails."

MPEP 2106 states:

"Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized...Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."

Claims 10 and 15 recite a computer program that does not recite a computer

readable storage medium, therefore, these claims are considered to be nonstatutory

functional descriptive material since the computer program's functionality cannot be

realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-11 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated

by US Patent 6,779,019 B1 to Mousseau et al.

Regarding claim 1, Mousseau disclosed a method of managing emails in a

mobile terminal ("mobile data communication device") of a mobile e-mail system, the

mobile email system comprising an email server ("network server" containing a

"redirector" program or "host system") coupled to a static terminal ("user's desktop PC")

and in wireless communication with said mobile terminal, said static terminal having a

folder-based data storage structure for storing emails received by a user of said static

terminal (see at least column 3, lines 25-51 and column 18, lines 28-51), said email

server also being configured to provide said received emails to said mobile terminal

(see at least column 3, lines 1-25), said mobile terminal locally duplicating at least a

portion of said static terminal folder-based data storage structure, whereby said user is

able to manage emails sent to a single address using said static and said mobile

terminal (see at least column 3, lines 1-17 and column 18, lines 28-51), the method

comprising:

inputting, at said mobile terminal, a command from said user to move an email

from a first folder of said local storage structure to a second folder of said local storage

structure; deleting said email from said local storage of said mobile terminal responsive

to said user move command; and sending said move command from said mobile

terminal to said email server. (see at least column 6, line 63-column 7, line 14, column

18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Claims 6-7, 11, and 14 are also rejected since these claims recite substantially

the same limitations as recited in claim 1. "Documents" are interpreted to be a broader

term for "emails", therefore, the teachings of Mousseau also encompass "documents".

Regarding claim 2, Mousseau disclosed the method as claimed in claim 1

wherein said first folder comprises an incoming mail-box of said mobile terminal. (see at

least column 19, lines 27-44, specifically a folder type "inbox") (see also column 18,

lines 28-51)

Regarding claim 3, Mousseau disclosed the method as claimed in claim 1

wherein said second folder of said storage structure local to said mobile terminal has

associated property data for specifying said second folder as a folder in which emails

are not to be stored locally in said mobile terminal, and wherein said deleting is

conditional upon said property data. (see at least column 6, line 63-column 7, line 14, column 18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Regarding claim 4, Mousseau disclosed the method as claimed in claim 1 wherein said sending of said move command comprises encoding said move command as a command email ("command message") and sending said command email. (see at least column 11, lines 20-34)

Regarding claim 5, Mousseau disclosed the method as claimed in claim 1 wherein said mobile terminal is in intermittent contact with said email server, said method further comprising connecting said mobile terminal to said server via an internet connection. (see at least column 10, lines 20-45)

Regarding claim 8, Mousseau disclosed a method of managing emails in a mobile email system, comprising: implementing the method of claim 1; (see references above regarding claim 1)

receiving said move command at said email server; and sending a command to perform said move to said static terminal. (see at least column 6, line 63-column 7, line 14, column 18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Claim 13 is also rejected since this claim recites substantially the same limitations as recited in claim 8.

Regarding claim 9, Mousseau disclosed the method as claimed in claim 8 wherein said email server comprises a first email server for receiving and sending emails to and from said user from and to a third party, and a second email server for sending emails to said mobile terminal and receiving and forwarding commands from

said mobile terminal; the method further comprising receiving said move command at said second email server and forwarding said move command to said first email server; and wherein said first email server performs said command sending to said static terminal. (see at least column 6, line 63-column 7, line 14, column 18, lines 28-51 and especially column 22, lines 57-column 23, line 23)

Claims 10 and 15 are also rejected since these claims recite substantially the same limitations as recited in claim 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./
Primary Examiner, Art Unit 2143